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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,702	12/30/2003	Sultan Ahmad	ASZN0039-101 (A1807-2P US)	2881
7590	02/22/2006		EXAMINER LI, RUIXIANG	
Michael A. Sanzo Fitch, Even, Tabin & Flannery Suite 401L 1801 K Street, N.W. Washington, DC 20006-1201			ART UNIT 1646	PAPER NUMBER

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/747,702

Applicant(s)

AHMAD ET AL.

Examiner

Ruixiang Li

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1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 8-40 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 7 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/30/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicants' election with traverse of Group III (claims 6, 7, and 41) in the reply filed on 01/24/2006 is acknowledged. The traversal is on the ground(s) that (i) the examiner has not met the prima facie burden and has not shown separate status in the art or a requirement for a different field of search; and (ii) Groups I, III, V, VII, IX, XI, and XIII have been classified into identical classes. This has been fully considered but is not found persuasive because while Groups I, III, V, VII, IX, XI, and XIII have the same class, they are drawn to entirely different products, i.e., various dorsal root receptors. These receptors have different structures as represented by separate SEQ ID NOS and require non-cohesive searches and considerations. Search and examination of more than one group is a burden for the examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-42 are pending. Claims 6, 7, and 41 are under consideration. All other claims are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

3. The information disclosure statements filed on 12/30/2003 have been considered and a signed copy has been attached to the office action.

Objection to the Title

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

5. The drawings filed on 12/30/2003 are accepted by the Examiner.

Priority

6. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Sweden on 12/22/1997. It is noted, however, that applicant has not filed a certified copy of the Sweden 9704836-7 application as required by 35 U.S.C. 119(b).

Claim Rejections—35 USC §112, 2nd paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6, 7, and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is indefinite because it recites "the amino acid sequence consisting functionally of human dorsal root receptor 1 (DRR-1)". It is understood in the art that a human dorsal root receptor consists of an amino acid sequence, not that an amino

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acid sequence consists of a human dorsal root receptor. Moreover, It is not clear what the metes and bounds of the term “consisting functionally of” are.

The non-elected claim 8, which claim 41 depends from, has the same issue as claim 6. Claims 7 and 41 are rejected as dependent claims.

It is suggested that claims 6 and 7 are amended as shown below:

Claim 6. A substantially pure protein comprising the amino acid sequence of SEQ ID NO: 3.

Claim 7. The protein of claim 6, wherein said protein consists of the amino acid sequence of SEQ ID NO: 3.

Claim Objections—Minor Informalities

9. Claims 7 and 41 are objected to because of the following informalities: (i). Claim 7 fails to further limit claim 6 because “consisting of” recited in claim 6 is a closed language, whereas “consisting essentially of” recited in claim 7 is an open language; (ii). Claim 41 depends on non-elected claim 40; (iii). Claim 41 recites non-elected subject matter; and (iv). An article at the beginning of claim 41 is missing. Appropriate correction is required.

Conclusion

10. No claims are allowed.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (571) 272-0875. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at the toll-free phone number 866-217-9197.

Ruixiang Li

Ruixiang Li, Ph.D.
Primary Examiner
February 18, 2006